

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte STEFAN REUSS, BRIAN D. WEST, DAVID J. DODGE and
CHRISTOPHER M. DOYLE

Appeal No. 2002-0394
Application No. 09/169,074

ON BRIEF

Before ABRAMS, STAAB and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-6, 8-11, 13, 14, 16, 18-42, 44-47, 49, 50 and 52-57. The examiner has subsequently withdrawn the rejection of claims 27-33 (see answer, Paper No. 22, page 2). Consequently, this appeal involves only claims 1-6, 8-11, 13, 14, 16, 18-26, 34-42, 44-47, 49, 50 and 52-57.¹

¹ Claims 27-33 stand allowed and claims 7, 12, 15, 43, 48 and 51 stand objected to as being dependent on a rejected base claim. No other claim is pending in this application.

BACKGROUND

The appellants' invention relates to a highback for gliding sports. As explained on page 1 of appellants' specification, a "highback" is used with snowboard binding systems for soft snowshoe boots and typically includes an upright member that supports the rear lower portion of a rider's leg to act as a lever that helps transmit forces to and from the board. As the stiffness of the highback increases, force transmission increases, resulting in more responsive board control. Conversely, as the stiffness of the highback decreases, force transmission decreases, resulting in less responsive board control. Riders may prefer a degree of adjustability in the highback stiffness for achieving a desirable balance between various highback characteristics (specification, page 2). Thus, an object of appellants' invention is to provide an improved highback having stiffness adjustability (specification, page 2). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The examiner relied upon the following prior art references of record in rejecting the appealed claims:

Hanson et al. (Hanson)	3,945,135	Mar. 23, 1976
Phillips	6,027,136	Feb. 22, 2000
		(filed Jan. 8, 1997)

The following rejection is before us for review.

Claims 1-6, 8-11, 13, 14, 16, 18-26, 34-42, 44-47, 49, 50 and 52-57 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Phillips in view of Hanson.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer for the examiner's complete reasoning in support of the rejection and to the brief and reply brief (Paper Nos. 21 and 23) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Each of independent claims 1, 34 and 37 before us on appeal recites a highback or highback body having an adjustable stiffness. Phillips, the primary reference relied upon by the examiner in rejecting the claims, discloses a system for use with a snowboard binding including a highback 50. The examiner² does not contend that Phillips' highback has an adjustable stiffness and, indeed, we find no disclosure of the highback 50 having an adjustable stiffness.

² The examiner's statement (answer, page 3) that "Phillips lacks a tension adjustment device" does not appear to have any relevance to appellants' claims, which do not call for a tension adjustment device.

Hanson is directed to a ski boot. The examiner's characterization of Hanson is set forth in the paragraph bridging pages 3 and 4 of the answer. We share appellants' view (brief, page 6) that the examiner has erred in considering the vamp 14, by itself or in combination with the beam 30, of Hanson's ski boot to be a "highback" as that term is understood in the art and as described in appellants' specification (page 1, lines 19-25). Furthermore, neither lateral adjustment of the cuff members 40, 42 using horizontal screw 36 nor adjustment of the screw 50 (or the knurled knob 51' fixed to the outer end of threaded member 50') will affect the stiffness of either the beam 30 or the vamp 14. Rather, lateral adjustment of the cuff members 40, 42 permits legs of different width to be accommodated (column 4, lines 1-4) and adjustment of the screw 50 or threaded member 50' provides a forward thrust on the rear portion of the liner 28, thereby providing a snugger fit (column 4, line 57, to column 5, line 25).

In any event, Hanson provides absolutely no suggestion to modify the highback of Phillips by providing a tension adjustment control device to control the stiffness of the highback to increase rider comfort, as the examiner asserts on page 4 of the answer. Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual

basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

For the foregoing reasons, it is our opinion that the combined teachings of Phillips and Hanson are insufficient to establish a prima facie case of obviousness³ of the subject matter of claims 1, 34 and 37. It follows that we cannot sustain the examiner's rejection of claims 1, 34 and 37, or claims 2-6, 8-11, 13, 14, 16, 18-26, 35, 36, 38-42, 44-47, 49, 50 and 52-57 which depend either directly or indirectly therefrom, as being unpatentable over Phillips in view of Hanson.

³ The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-6, 8-11, 13, 14, 16, 18-26, 34-42, 44-47, 49, 50 and 52-57 under 35 U.S.C. § 103 is reversed.

REVERSED

NEAL E. ABRAMS
Administrative Patent Judge

LAWRENCE J. STAAB
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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